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EXAMINER	
NGUYEN, THUY-VI THI	
ART UNIT	PAPER NUMBER
3689	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/772,439	GAIK, LEONARD J.	
	Examiner	Art Unit	
	THUY-VI NGUYEN	3689	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *20 April 2009*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,3-11,13-23 and 30* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1, 3-11, 13-23, 30* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. This is in response to the applicant's communication filed on April, 20, 2009 wherein:

Claims 1, 3-11, 13-23 and 30 are currently pending;

Claims 2, 12, 24-29 have been cancelled;

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. **Claims 1, 3-11, 13-23 and 30** are reject under 35 U.S.C. 101 based on Supreme Court precedent, and recent Federal Circuit decisions, the Office's guidance to examiners is that a § 101 process must

(1) be tied to another statutory class (such as a particular apparatus) or

(2) transform underlying subject matter (such as an article or materials).

Diamond v. Diehr, 450 U.S. 175, 184 (1981); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70 (1972). If neither of these requirements is met by the claim, the method is not a patent eligible process under §101 and is non-statutory subject matter. With respect to claims 1-23, and 30, the claim language does not transform the underlying subject matter and the process is not tied to another statutory class such as the process steps of "*acquiring….; transferring….; delivering…*; arranging ….; selecting…..". Even though the last step in claim 1 recites "*playing said*

selection in said public medium" the involvement of the machine or transformation in the claimed process must not merely be insignificant extra-solution activity. This means reciting a specific machine or a particular transformation of a specific article in an insignificant step. *See Flook*, 437 U.S. at 590. Therefore the claims are directed to nonstatutory subject matter.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. Claims 1-23, 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over WILKS (US Patent Application Publication US 2002/0129693) in view of ISHII (US 2002/0154759).

As for independent claim 1, WILKS discloses a method of arranging for a provision of music from a provider of music to an operator of a public medium comprising the following steps:

c) delivering or providing said selection of music from said provider of music to said operator;

{see par 0008, music distribution (provider) provides the music or selection of songs to the business owner (operator)}

d) playing said selection in said public medium

{see pars. 0008; par. 0012}.

Note: As for the claim language" acquiring the right, and transferring the right" in steps a and b) is determined to be is non-functional descriptive material and was not given patentable weight (MPEP § 2106.01). "A right" is not functional because it does not alter how the process steps are to be performed to achieve the utility of the invention.

WILK discloses the claimed invention above, except for the operator gives the right to play the music to the provider (steps a and b).

ISHII is cited to teach a system wherein the music provider provides a selection of music for the operator to play in the operator's business environment for advertising purpose whereby the provider inherently acquires from the business operator a right to play of music as uploading the music to the operator server {see par. [0080-0085]}.

Therefore, it would have been obvious to modify the delivering/providing the music from the music provider to the business owner to play in the public medium of

WILKS to include the right of the operator to the provider for uploading the music data to the business operator as taught by ISHII for the advertising purpose such as promoting the music.

As for claim 3, Wilks discloses the step of selecting the operator [operator such as restaurant, bars, client computer; par. 0007, lines 2-5; par. 0015, lines 1-2].

As for claim 4, Wilks discloses the step of selecting the provider of music [see par. 0012, lines 4-6];

As for claim 5, Wilks discloses the step of selecting the operator [...operator such as restaurant, bars and client computer; par. 0007, lines 2-5; par. 0015, lines 1-2].

As for claim 6, Wilks discloses the step of selecting from the provider of music an appropriate selection of music to play in said public medium [...see par. 0012, lines 3-5 and figure 3].

As for claim 7, Wilks discloses the step of arranging for the payment of copyright license fees to the owners of a copyright subsisting in said music [see par. 0031, lines 12-13, lines 22-24].

As for claim 8, Wilks discloses wherein the public medium is selected from a group consisting of retail stores, bars, sports stadiums, sports arenas, hand-held devices including personal communication devices, mobile phones and personal digital assistants, phone line holding ports and on-line websites [operator such as restaurant, bars, client computer; par. 0007, lines 2-5; par. 0015, lines 1-2].

As for claim 9, Wilks discloses wherein the provider of music is selected from a group consisting of a record company, a record producer, a music publisher, record

distributor, a recording studio, an individual artist, an individual, a music provider and an agent for musical artists [...music distribution company; remote multimedia server/music provider; see par. 0008, lines 6; par. 0026, lines 1-6].

As for claim 10, Wilks discloses wherein the right to play a selection of music in said public medium is at a pre-determined time and for a pre-determined length of time [see par. 0031, lines 2-5].

As for claim 11, Wilks discloses a method of acquiring music for an operator of a public medium to play in said medium comprising the following steps:

a) arranging with the operator to find a provider of music based on a set of criteria [...arranged by type of music, artist name, music type; see par. 0017, lines 3-8; par. 0040, lines 4-8 and figures 3 and 4];

b) selecting an appropriate provider of music based on said set of criteria; and [...selection of songs from a variety of music types; see par. 0012; par. 0017, lines 3-8 and figures 3-4].

d) delivering or providing said music from the provider of music to the operator {see par 0008, music distribution (provider) provides the music or selection of songs to the business owner (operator)}.

As for the claim language" acquiring the right, and transferring the right" in step c is determined to be is non-functional descriptive material and was not given patentable weight (MPEP § 2106.01). "A right" is not functional because it does not alter how the process steps are to be performed to achieve the utility of the invention.

WILK discloses the claimed invention above, except for the operator gives the right to play the music to the provider (step c).

ISHII is cited to teach a system wherein the music provider provides a selection of music for the operator to play in the operator's business environment for advertising purpose whereby the provider inherently acquires from the business operator a right to play of music as uploading the music to the operator server {see par. [0080-0085]}.

Therefore, it would have been obvious to modify the delivering/providing the music from the music provider to the business owner to play in the public medium of WILKS to include the right of the operator to the provider for uploading the music data to the business operator as taught by **ISHII** for the advertising purpose such as promoting the music.

As for claim 13, Wilks discloses wherein the provider of music is selected according to a pre-selected set of criteria provided by the operator [...remote multimedia server (RS 18) has created a menu contain the music criteria for user select; see par. 0037, lines 11-21].

As for claim 14, Wilks discloses the step of selecting from the provider of music an appropriate selection of music to play in said public medium [see par. 0012, lines 3-5 and figure 3].

As for claim 15, Wilks discloses the step of arranging for the payment of copyright license fees to the owners of a copyright subsisting in said music [see par. 0031, lines 12-13, lines 22-24].

As for claim 16, Wilks discloses wherein the public medium is selected from a group consisting of retail stores, bars, sports stadiums, sports arenas, hand-held devices including personal communication devices, mobile phones and personal digital assistants, phone line holding ports and on-line websites [operator such as restaurant, bars, client computer; par. 0007, lines 2-5; par. 0015, lines 1-2].

As for claim 17, Wilks discloses wherein the provider of music is selected from a group consisting of a record company, a record producer, a music publisher, a record distributor, a recording studio, an individual artist, a music provider and an agent for musical artists [...music distribution company; remote multimedia server/music provider; see par. 0008, lines 6; par. 0026, lines 1-6].

As for claim 18, Wilks discloses wherein the right to play a selection of music in said public medium is at a pre-determined time and for a pre-determined length of time [see par. 0031, lines 2-5].

As for claim 19, Wilks discloses a method of arranging a business transaction comprising the following steps:

a) selecting a provider of music [...selecting a variety of artist; see par. 0012; lines 3-6];

b) selecting an operator of a public medium wherein said medium is appropriate for playing music of the provider of music based on a set of pre-determined criteria provided by said operator

[...interactive multimedia system (IMS12) provides a menu with including the music criteria for a user to chose and play; see par.0014, lines 12-14; par. 0016; par. 0017, lines 4-9; par. 0037, par. 0048; and figures 1-2].

d) delivering or providing said music from the provider of music to the operator {see par 0008, music distribution (provider) provides the music or selection of songs to the business owner (operator)}

Note: As for the claim language" acquiring the right, and transferring the right" in steps a and b) is determined to be is non-functional descriptive material and was not given patentable weight (MPEP § 2106.01). "A right" is not functional because it does not alter how the process steps are to be performed to achieve the utility of the invention.

WILK discloses the claimed invention above, except for the operator gives the right to play the music to the provider (step c).

ISHII is cited to teach a system wherein the music provider provides a selection of music for the operator to play in the operator's business environment for advertising purpose whereby the provider inherently acquires from the business operator a right to play of music as uploading the music to the operator server {see par. [0080-0085]}.

Therefore, it would have been obvious to modify the delivering/providing the music from the music provider to the business owner to play in the public medium of WILKS to include the right of the operator to the provider for uploading the music data to the business operator as taught by ISHII for the advertising purpose such as promoting the music.

As for claim 20, Wilks discloses the step of arranging for the payment of copyright license fees to the owners of a copyright subsisting in said music [see par. 0031, lines 12-13, lines 22-24].

As for claim 21, Wilks discloses wherein the public medium is selected from a group consisting of retail stores, bars, sports stadiums, sports arenas, hand-held devices including personal communication devices, mobile phones and personal digital assistants, phone line holding ports and on-line websites [operator such as restaurant, bars, client computer; par. 0007, lines 2-5; par. 0015, lines 1-2].

As for claim 22, Wilks discloses wherein the provider of music is selected from a group consisting of a record company, a record producer, a music publisher, a record distributor, a recording studio, an individual artist, a music provider and an agent for musical artists [...music distribution company; remote multimedia server/music provider; see par. 0008, lines 6; par. 0026, lines 1-6].

As for claim 23, Wilks discloses wherein the right to play a selection of music in said public medium is at a pre-determined time and for a pre-determined length of time [see par. 0031, lines 2-5].

As for claim 30, Wilks disclose wherein there is no cost to a member of the public for accessing said music from said public medium [see par. 0006, lines 1-4].

Response to Arguments

5. Applicant's arguments with respect to claims 1-23, 30 have been considered but are moot in view of the new ground(s) of rejection.

As for 101 rejection, On page 6 of the remark, Applicant stated that "As set out in In re Bilski, a method or process must be tied to a particular machine or transforms an article into a different state or thing. As set out in the amended claims, the claims are directed to providing music from a provider of music to an operator (independent claims 1, 11, 19) and in the course of carrying out the method of the claims, rights are transferred from an operator to a provider of music and music is delivered from the provider to the operator. As a result, music which may otherwise be maintained by a provider of music is delivered to an operator for playing in a public medium. Applicant submits that this transformation meets the requirements for patentability required" is note. However this is not persuasive. The examiner notes the claim recites the rights are transferred from an operator to a provider of music and music is delivered from the provider to the operator does not transform the underlying subject matter and the process Is not tied to another statutory class.

Based on Supreme Court precedent, and recent Federal Circuit decisions, the Office's guidance to examiners is that a § 101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials). Diamond v. Diehr, 450 U.S. 175, 184 (1981); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70 (1972). If neither of these requirements is met by the claim, the method is not a patent eligible process under §101 and is non-statutory subject matter. With respect to claims 1-23, and 30, the claim language does not transform the underlying subject matter and the process is not tied to another statutory class such as the process steps of

"*acquiring….; transferring….; delivering…*; arranging ….; selecting…..". Even though the last step in claim 1 recites "*playing said selection in said public medium"* the involvement of the machine or transformation in the claimed process must not merely be insignificant extra-solution activity. This means reciting a specific machine or a particular transformation of a specific article in an insignificant step. *See Flook*, 437 U.S. at 590. Therefore the claims are directed to nonstatutory subject matter.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thuy-Vi Nguyen whose telephone number is 571-270-1614. The examiner can normally be reached on Monday through Thursday from 8:30 A.M to 6:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janice Mooneyham can be reached on 571-272-6805. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/T. N./

Examiner, Art Unit 3689

/Tan Dean D. Nguyen/
Primary Examiner, Art Unit 3689
7/1/09